

## **REMARKS**

### **Status of Claims**

The Office Action mailed 29 September 2006 has been received and reviewed. Each of claims 8-16 stand rejected. Claims 1-7 and 17-26 are withdrawn and claims 8 and 16 are amended herein. Reconsideration of the present application in view of the following remarks is respectfully requested.

### **Restriction Requirement**

Claims 1-26 stand restricted under 35 U.S.C. § 121 because the claims are related to different subject matter.

Applicant hereby elects claims 8-16, which are the claims of Group II. Applicant has withdrawn non-elected claims 1-7 and 17-26. However, Applicant reserves the right to file a divisional application directed to the subject matter of non-elected claims prior to the issuance of the above-identified application.

### **Objection to the Specification**

The title was objected to because of its length. The title has been amended to "Tracking Switch Transactions." Accordingly, withdrawal of the objection to the specification is respectfully requested.

### **Objection to the Drawings**

The Office objected to the drawings under 37 C.F.R. 1.83(a) for failing to illustrate every feature specified in the claims. Also the Office objected to the drawings for not having a "Prior Art" label when illustrating conventional technology.

FIGS. 2 and 3 are amended and new FIG. 5 is presented to overcome the objections to the drawings. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

### **Rejections based on 35 U.S.C. § 101**

Claim 16 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Office indicated that claim 16 is directed to a non-statutory claim of a signal. Applicant has amended claim 16 to state computer-storage media to indicate that claim 16 is directed to a tangible storage media. Accordingly, withdrawal of the non-statutory subject matter rejection is respectfully requested.

### **Rejections based on 35 U.S.C. § 102(b)**

#### **A.) Applicable Authority**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP § 2131.

#### **B.) Anticipation Rejection Based on U.S. Patent No. 5,559,313 (“Claus”).**

Claims 8-10 and 12-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Claus. This rejection is respectfully traversed because the prior art does not disclose all elements of amended independent claim 8.

With respect to independent claim 8, Applicant respectfully submits that the cited prior art, including Claus, fails to describe, among other things, the following amended claim element: “receiving a network configuration transaction; . . . [and] maintaining a second table that stores transaction-dependent data representing transaction statuses corresponding to the network configuration transaction,” as recited in independent claim 8.

Unlike Claus, the claimed invention of claim 8 processes a network configuration transaction received by a switch. Transaction statuses corresponding to the network configuration transaction are stored by the switch in a second table storing transaction-

dependent data. The transaction statuses provide an indication of progress through transitional states associated with substeps of the network configuration transaction. Claus is directed to processing purchase transactions conducted at Point of Sale (POS) terminals not network configuration transactions received by a switch. Claus fails to teach all elements of amended claim 8. Accordingly, for at least the above reasons, withdrawal of the anticipation rejection of claim 8 is respectfully requested.

Dependent claims 9-10 and 12-16 further define novel features of the claimed invention of claim 8 and each depend either directly or indirectly, from independent claim 8. Accordingly, for at least the reasons set forth above with respect to independent claim 8, dependent claims 9-10 and 12-16 are believed to be in condition for allowance by virtue of their dependency. *See, In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); *see also*, MPEP § 2143.01. As such, withdrawal of the anticipation rejection of dependent claims 9-12, and 12-16 is respectfully requested.

#### **Rejections based on 35 U.S.C. § 103(a)**

##### **A.) Applicable Authority**

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP §2143 through §2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)”. MPEP §2143. Further, in

establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat. App. & Inter. 1985).” *Id.* See also MPEP §706.02(j) and §2142.

B.) Obviousness Rejection Based on Claus in view of Applicant’s specification at page 1, paragraph [0005] (“Applicant’s Admitted Prior Art).

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Claus in view of Applicant’s Admitted Prior Art. This rejection is respectfully traversed because all claim limitations are not taught or suggested by the prior art.

Dependent claim 11 further defines novel features of the claimed invention of claim 8 and depends indirectly from independent claim 8. Accordingly, for at least the reasons set forth above with respect to independent claim 8, dependent claim 11 is believed to be in condition for allowance by virtue of its dependency. See, *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); see also, MPEP § 2143.01. As such, withdrawal of the obviousness rejection of dependent claim 11 is respectfully requested.

### **CONCLUSION**

For the reasons stated above, claims 8-16 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 8-16. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 21-0765.

Respectfully submitted,

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